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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 770,107	01 24 2001	Joanne M. Meyer	3322 0H401	5349

7590 10 28 2002

DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

WILDER, CYNTHIA B

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 10 28 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/770,107

Applicant(s)
MEYER et al.

Examiner
Cynthia B Wilder

Art Unit
1637



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 5, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 and 54-62 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-44 and 54-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). | 6) <input type="checkbox"/> Other: |

Art Unit: 1637

DETAILED ACTION

1. Applicant's amendment filed in Paper No.10 is acknowledged. Claims 44-53 have been canceled. Claims 54-62 are pending. Claim 1-44 and 54-62 are pending.
2. Applicant's election with traverse of claims 1-20 of Group I in Paper No. 10 is acknowledged. However, Applicant's submission of new claims 54-62 drawn to Group I comprise subject matter that needs further restriction. Accordingly, a new restriction requirement under 35 U.S.C. 121 is deemed proper and appears below.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1-20 and 54-62 drawn to an isolated nucleic acid and kit, classified in class 536, subclass 24.3 and 24.33.
 - II. Claims 21-43, drawn to a method of detecting DISC1 allelic variant, classified in class 435, subclass 6.

Sequence Election Requirement Applicable to All Groups

In addition, each Group detailed above reads on patentably distinct SEQ ID Numbers (SEQ ID NO:). Each sequence is patentably distinct because the sequences are structurally unrelated sequences and a further restriction is applied to each Group. Applicant must further elect a single SEQ ID NO: (See MPEP 803.04). Applicant must specifically identify each of the corresponding SEQ ID NO: X or SEQ ID NO:Y for the sequence elected. Applicant is to elected **one** (single)

Art Unit: 1637

SEQ ID NO: from SEQ ID NOS: 1 and 4, one sequence (SEQ ID NO:) from SEQ ID NO: 33-43 and one primer pair (2 SEQ ID NOS) from SEQ ID NO: 44-127 for prosecution on the merit along with the elected group.

Applicant is advised that examination will be restricted to only the elected SEQ ID NO: and should not be construed as a species election.

4. The inventions are distinct, each from the other because of the following reasons: ~~Inventions~~ I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product comprising the isolated nucleic acid and kit can be used in a materially different process such as in methods of differential display to determine gene expression or in methods of nucleic acid sequencing or in antisense studies.

5. Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

6. A telephone call was made to Sam Woodley on 10/18/2002 to request an oral election to the above restriction requirement, but did not result in an election being made

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1637

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

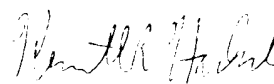
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cynthia Wilder whose telephone number is (703) 305-1680. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached at (703) 308-1119. The official fax phone number for the Group is (703) 308-4242. The unofficial fax number is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group's Patent Analyst, Monica Graves at (703) 305-3002 or Group's receptionist at (703) 308-0196.

Cynthia B. Wilder, Ph.D.

October 24, 2002


KENNETH R. HORLICK, PH.D.
PRIMARY EXAMINER

10/24/02